

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID BRIAN EDWARDS,
WILLIAM JOHN McCARTHY and PATRICIA RICHARDSON

Appeal No. 2003-1380
Application No. 09/525,083

MAILED

SEP 24 2003

ON BRIEF

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10,
which are all of the claims pending in this application.

We REVERSE AND ENTER A NEW REJECTION UNDER 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a water soluble package. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Dickler et al. (Dickler) 6,037,319 Mar. 14, 2000
(filed Apr. 1, 1997)

Claims 1 and 5-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dickler.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickler.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 25) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 24) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

The objective of the appellants' invention is to provide a water soluble package for detergent compositions which has greater resistance to failure due to impact when a plurality of packages are loosely packed in a container for shipping. According to the appellants, the generally dome shaped configuration accomplishes this goal. The invention is manifested in claim 1 in the following manner:

1. A water soluble package containing a fluid substance for release on dissolution of the package, characterised in that the package has a body portion for containing the substance comprising a first sheet of a water soluble material thermoformed to form a body wall of the body portion, and a second sheet of water soluble material superposed on the first sheet and sealed thereto along a continuous region of the superposed sheets to form a base wall of the body portion, and in that the body portion of the package is generally dome shaped.

New Rejection Under 37 CFR § 1.196(b)

At the outset, this panel of the Board finds it necessary to enter the following new rejection:

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. We are mindful that the appellants are free to claim their invention in broad terms, and are entitled to the broadest reasonable interpretation of the claim language. However, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 USC § 112

is directed. See In re Hammack 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, it is our opinion that the scope to be accorded to "generally dome shaped" cannot be determined with a reasonable degree of precision and particularity. This being the case, independent claim 1 is indefinite, as are claims 2-10, which depend therefrom. Our reasoning for arriving at this conclusion follows.

Claim 1 recites that the body portion of the package is "generally dome shaped." The common applicable definition of "dome" is "hemispherically" shaped,¹ and the question arises as to what extent a shape may deviate from a hemispherical shape and still be within the scope of the claim, that is, be "generally" dome shaped. No explanation has been provided in the specification in the way of guidance for establishing the scope that is to be accorded to this terminology, which as used in the claim is a term of degree. In the statement of the invention on pages 3 and 4 of the specification, the "package" of the invention is described as being in the shape of a "dome." "Dome" also is used on page 6 in describing the mold used to impart the shape to the one of the sheets that forms the body portion. However, on page 8, where an example is provided of forming the body portion, the terminology "generally dome shaped" is used to describe the shape of the mold.

¹Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 344.

Some forms that are not truly in the shape of a "dome" are, however, disclosed in the application. The specification states on page 4 that "[f]or, example, dome shapes having rectangular, oval, square and triangular bases are envisaged" (emphasis added). Such forms are illustrated in Figure 2d (square), Figure 3d (oval), Figure 4d (triangular), and Figure 5d (rectangular), from which it is clear that the shapes deviate from being a "dome" in that the bases of the upstanding portions are not circular and as a result the upwardly extending surfaces are not hemispherical. This would indicate that the appellants consider these forms to be "generally dome shaped." However, the full range of the forms that fall within the scope of the terminology in issue is not determinable from the original disclosure.

The Examiner's Rejections

Independent claim 1 and dependent claims 5-10 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Dickler, and claims 2-4 under 35 U.S.C. § 103(b) as being unpatentable over Dickler. When no definite meaning can be ascribed to certain terms in a claim, the subject matter does not become unpatentable, but rather the claim becomes indefinite. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since a rejection cannot be based upon speculation and assumptions, we are constrained to

reverse the examiner's rejections. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). We hasten to point out, however, that this action should not be construed as an indication that the claimed subject matter would or would not have been unpatentable in view of the prior art cited against the claims. We have not addressed this issue, for to do so would require on our part the very speculation which formed the basis of our rejection under Section 112.

The rejections of claims 1 and 5-10 as being anticipated by Dickler, and of claims 2-4 as being unpatentable over Dickler, are not sustained.

CONCLUSION

None of the examiner's rejections are sustained.

The decision of the examiner is reversed.

A new rejection of claims 1-10 has been entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options

with respect to the new ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR §1.196(b)



IRWIN CHARLES COHEN
Administrative Patent Judge

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